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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,594	06/06/2001	Srinivas V.R. Gutta	US010125	7185

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EXAMINER

WOO, ISAAC M

ART UNIT PAPER NUMBER

2166

DATE MAILED: 10/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/875,594

Applicant(s)

GUTTA ET AL.

Examiner

Isaac M. Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7-11 and 17-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7-11 and 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2005 has been entered.

2. Claims 1-3, 9-11 and 17-19 are amended. Claims 20-22 are newly added. Claims 4-8 and 12-16 are canceled. The pending claims are 1-3, 9-11 and 17-22.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-3, 7-11 and 17-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600,1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claims 1-3, the preamble of "A method for determining whether to recommend a program, said method comprising", can be implemented without computer or machine. Because the limitation of claims 1-3, "receiving", retrieving", "converting", "identifying" and "determining", can be implemented by a human with a pencil, and a piece of paper for searching an electronic document. Thus, the languages of claims 1-3 raise a question as to whether the claimed method is directed merely to an abstract idea that is not tied to a producing a concrete, useful, and tangible result to from the basis of statutory subject matter under 35 U.S. C. § 101. Therefore, the claimed invention is non-statutory subject matter. The claims should be amended to indicate that the subject matter is implemented by a computer, i.e., a computer implemented method.

As set forth in MPEP 2106 (II) (A):

Products may be either machines, manufactures, or compositions of matter.

A machine is " a concrete thing, consisting of parts or of certain devices and combinations of devices." Burr v. Duryee, 68 U.S. (1 Wall.) 531, 570 (1863).

.....

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in term of its hardware or hardware and software combination, it defines a statutory product. See, e.g., Lowry, 32 F.3d at 1583, 32 USPQ2d at 1034-35; Waremerdam, 33 F.3d at 1361-62, 31 USPQ2d at 1760.

Regarding claims 9-11 and 17-19, a computer system and a computer program product, include *no physical structure of the machine in terms of its hardware or hardware and software combination*. Because the limitation of claims 9-11 and 17-19, "module" and "computer readable code" are computer system and computer program product that are not embedded any a computer-readable medium and run by any a computer or machine. Therefore, the claims are not a statutory system and should be rejected under 35 U.S. C. § 101 as not being tangible.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 7-11 and 17-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Uehara et al (U.S. Pub No. 2002/0056095, hereinafter, "Uehara").

With respect to claim 1, Uehara discloses, receiving a first program record representing a first program (page 4, section [0058], video content are recorded in video

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contents storing part 43, fig. 4), wherein the first program record includes at least one key field (keywords, fig. 3, page 4, sections [0058-0060], 700, fig. 7, page 7, section [0091]); retrieving a plurality of program records from a database, wherein at least one of the program records includes at least one key field, see (111-112, fig. 11, page 9, sections [0112-0113], program records are stored with key fields (keywords) and extracted to compare with the others); converting each key field of the first program record into a feature value, see (fig. 6A, page 5, section [0070], 45, feature value extracting part, fig. 4, page 5, sections [0067-0069], page 6 sections [0083]); identifying a second program record of the plurality of program records that qualifies as a nearest neighbor of the first program record using the feature value, see (classification, 802-804, fig. 8, page 7, sections [0092-0099]), the key fields of the plurality of program records and a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]); and determining, based on the identified second program record, whether to recommend the first program, see (sections [0092-0099], classification of program records provides recommendation of program records).

With respect to claim 2, Uehara discloses, receiving a first program record representing a first program (page 4, section [0058], video content are recorded in video contents storing part 43, fig. 4), wherein the first program record includes at least one key field (keywords, fig. 3, page 4, sections [0058-0060], 700, fig. 7, page 7, section [0091]); retrieving a plurality of program records from a database, wherein at least one of the program records includes at least one key field, see (111-112, fig. 11, page 9,

sections [0112-0113], program records are stored with key fields (keywords) and extracted to compare with the others); converting each key field of the first program record into a feature value, see (fig. 6A, page 5, section [0070], 45, feature value extracting part, fig. 4, page 5, sections [0067-0069], page 6 sections [0083]); identifying N number of program record of the plurality of program records that qualifies as a nearest neighbor of the first program record using the feature value, see (classification, 802-804, fig. 8, page 7, sections [0092-0099]), the key fields of the plurality of program records and a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]); and determining, based on the identified second program record, whether to recommend the first program, see (sections [0092-0099], classification of program records provides N number of recommendation of program records).

With respect to claim 3, Uehara discloses, receiving a first program record representing a first program (page 4, section [0058]; video content are recorded in video contents storing part 43, fig. 4), wherein the first program record includes at least one key field (keywords, fig. 3, page 4, sections [0058-0060], 700, fig. 7, page 7, section [0091]); retrieving a plurality of program records from a database, wherein at least one of the program records includes at least one key field, see (111-112, fig. 11, page 9, sections [0112-0113], program records are stored with key fields (keywords) and extracted to compare with the others); converting each key field of the first program record into a feature value, see (fig. 6A, page 5, section [0070], 45, feature value

extracting part, fig. 4, page 5, sections [0067-0069], page 6 sections [0083]); identifying a cluster of program record of the plurality of program records that qualifies as a nearest neighbor of the first program record using the feature value, see (classification is a cluster of program records, 802-804, fig. 8, page 7, sections [0092-0099]), the key fields of the plurality of program records and a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]); and determining, based on the identified second program record, whether to recommend the first program, see (page 7, sections [0092-0099], classification of program records provides N number of recommendation of program records).

With respect to claims 9-11, Uehara discloses, database storing a plurality of program records (page 4 section [0058], video content are recorded in video contents storing part 43, fig. 4), wherein each program record includes at least one key field (keywords, fig. 3, page 4, sections [0058-0060], 700, fig. 7, page 7, section [0091]); and module operable to determine a first, N number and cluster program records of the plurality of program records that qualifies as a nearest neighbor, using a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]) of a second program record in response to a reception of the second program record by the computer system using the key fields of the program records, see (classification is a cluster of program records, 802-804, fig. 8, page 7, sections [0092-0099]), the key fields of the plurality of program records and a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]); the

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module to determine, based on the first program record, whether to recommend a program represented by the second program record.

With respect to claims 17-19, Uehara discloses, receiving a first program record representing a first program (page 4 section [0058], video content are recorded in video contents storing part 43, fig. 4), wherein the first program record includes at least one key field (keywords, fig. 3, page 4, sections [0058-0060]. 700; fig. 7, page 7, section [0091]); retrieving a plurality of program records from a database, wherein at least one of the program records includes at least one key field, see (111-112, fig. 11, page 9, sections [0112-0113], program records are stored with key fields (keywords) and extracted to compare with the others); converting each key field of the first program record into a feature value, see (fig. 6A, page 5, section [0070], 45, feature value extracting part, fig. 4, page 5, sections [0067-0069], page 6 sections [0083]); identifying a program record, N number of records and a cluster of program record of the plurality of program records that qualifies as a nearest neighbor of the first program record using the feature value, see (classification includes a program record, N number of program records and a cluster of program records, 802-804, fig. 8, page 7, sections [0092-0099]), the key fields of the plurality of program records and a distance measurement method (one of classification methods, fig. 8, page 7, sections [0092-0099]); and determining, based on the identified second program record, whether to recommend the first program, see (page 7, sections [0092-0099], classification of program records provides N number and a cluster of recommendation of program records).

With respect to claim 20, Uehara discloses, comparing a number of positive counts for the identified second program record to a number of negative counts for the identified second program record, see (page 5, sections [0061-0071]).

With respect to claim 21, Uehara discloses, generating a recommendation of the first program if the determination is to recommend, see (page 5, sections [0061-0071]).

With respect to claim 22, Uehara discloses, recommending the first program if the determination is to recommend, see (page 5, sections [0061-0071]).


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on (571) 272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IMW
October 6, 2005


JEAN M. CORRIELUS
PRIMARY EXAMINER